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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

In re Patent Application of

Atty Dkt. 3813-3

C# M#

WHITEHEAD

TC/A.U.: 3625

Serial No. 09/863,010

Examiner: Y. Garg

Filed: May 23, 2001

Date: October 26, 2005

Title: SERVICE SUBSCRIPTION SERVICE BUSINESS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

☐ Correspondence Address Indication Form Attached.

☒ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences  
from the last decision of the Examiner twice/finally rejecting  
applicant's claim(s).

\$500.00 (1401)/\$250.00 (2401) \$ 250.00

☐ An appeal **BRIEF** is attached in the pending appeal of the  
above-identified application

\$500.00 (1402)/\$250.00 (2402) \$

☐ Credit for fees paid in prior appeal without decision on merits

-\$ ( )

☐ A reply brief is attached in triplicate under Rule 41.41

(no fee)

☒ Pre-Appeal Brief Request for Review form attached.

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this  
paper and attachment(s)

One Month Extension \$120.00 (1251)/\$60.00 (2251)

Two Month Extensions \$450.00 (1252)/\$225.00 (2252)

Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)

Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on

-\$ ( )

**TOTAL FEE ENCLOSED \$ 250.00**

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension.  
The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or  
asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this  
firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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By Atty: Alan M. Kagen, Reg. No. 36,178

Signature: Alan M. Kagen

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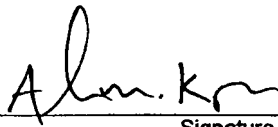
Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		3813-3
Application Number		Filed
09/863,010		May 23, 2001
First Named Inventor		Whitehead
Art Unit	Examiner	
3625	Y. Garg	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> Applicant/Inventor</p> <p><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> Attorney or agent of record 36,178 (Reg. No.)</p> <p><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34</p>		<p> Signature</p> <p>Alan M. Kagen</p> <p>Typed or printed name</p> <p>703-816-4031 Requester's telephone number</p> <p>October 26, 2005 Date</p>
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p>		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and selection option 2.

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## REASONS FOR REVIEW

In the "Response to Arguments" section in the Final Office Action dated August 16, 2005, the Office Action contends that a feature of the invention where one or more offers is automatically accepted is not recited in the claims. To the contrary, however, independent claim 1 defines in step (c), "if the user profile incorporates an automatic best choice service, automatically implementing the relevant items, and communicating the implemented relevant items to the user." Emphasis added. A similar feature is included in independent claims 14, 21 and 22. The contention in the Office Action that this subject matter is not recited in the rejected claims is thus inaccurate.

Moreover, in rejecting this feature of the invention, with reference to the Herz publication, the Office Action contends that "informing the shopper automatically of the best offers based upon his profile and the offer stored in a database reads upon the recited limitation." See the Office Action at page 5, lines 21-22. Since the claimed invention defines an automatic best choice service where relevant items are automatically implemented, Applicant respectfully submits that merely informing the shopper of the best offers in fact does not read upon the recited limitation.

See also, the Amendment filed May 31, 2005 at page 4, line 12 - page 5, line 9.